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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,046	08/29/2000	William T. Geddes Jr.	3503-0101P	8374

30593 7590 04/14/2004

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EXAMINER

WONG, LESLIE

ART UNIT

PAPER NUMBER

2177

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/650,046

Applicant(s)

GEDDES JR. ET AL.

Examiner

Leslie Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-137 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-137 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8&9/Aug27&Oct10 03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Receipt of Applicant's Amendment, filed 23 December 2003, is acknowledged.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 36, 52, and 61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 36, lines 2, 4, and 5; claims 52 and 61, lines 2 and 4, the term "adapted to" is unclear. It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Claims 37-44, 85-86, 124-125, 53-58, 62-70, 128-129, and 130-131 are rejected for fully incorporating the deficiencies of their respective base claims by dependency.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6, 12, 13, 17, 20-25, 33, 35-38, 40, 41, 44-46, 48, 49, 52-54, 56-57, 60-67, 69-76, 79-137 are rejected under 35 U.S.C. 102(e) as being anticipated by Sherwin et al. (U.S. 2002/0052784).

Regarding claims 1, 52, 61, 71, and 94-97, **Sherwin** teaches a search method for a computer device, comprising:

- a). associating a user of the computer device with at least one of a plurality of beneficiary groups (¶9); and
- b). providing an arrangement for searching for a provider based upon a search request input to the computer device, the provider being associated with a beneficiary group associated with the user (¶9).

Regarding claim 2, **Sherwin** further teaches wherein the input search request includes a request to search for a provider of one of a good, service and information (¶28).

Regarding claims 3, 64-66, and 72, **Sherwin** further teaches the steps of:

- a). receiving the input search request including a user-specified beneficiary

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group from the computer device of a user (§26);

b). searching for a provider, based upon the search arrangement and the received input search request including the user-specified beneficiary group, the search arrangement including a synergistic concentric circle arrangement (§s 24 and 26); and

c). outputting results of the search to the user (§31).

Regarding claims 4, 23, 48, and 74, **Sherwin** further teaches wherein the search arrangement includes an expandable synergistic concentric circle arrangement (§29).

Regarding claims 5, 6, 24, 25, 49, 75, and 76, **Sherwin** further teaches receiving information from the user for expanding at least one of the synergistic concentric circles of the synergistic expandable concentric circle arrangement (§28).

Regarding claims 12, 107, and 117, **Sherwin** further teaches wherein the step of providing includes providing an arrangement for searching on the Internet (§31).

Regarding claims 13, 108, 116, and 118, **Sherwin** further teaches wherein the step of providing includes providing an arrangement for searching on the worldwide web (§31).

Regarding claims 17, 33, 40, 41, 56, 57, 69, and 70, **Sherwin** further teaches

wherein the search priorities include priorities for expanding within an associated beneficiary group or among plural associated beneficiary groups (§31).

Regarding claims 20, 35, 109, and 119, **Sherwin** further teaches the computer device includes one of a personal computer, personal digital assistant and wireless phone (Fig. 1).

Regarding claim 21, **Sherwin** further teaches wherein a synergistic concentric circle is expandable based upon a redefined beneficiary group (§28).

Regarding claims 22, 104, 105, and 110, **Sherwin** further teaches search method for a computer device, comprising:

- a). receiving, from a computer device, a search request for a provider of a good, service or information and at least one beneficiary group (§26);
- b). searching for the requested provider, associated with the at least one beneficiary group, based upon the received search request including at least one user-specified beneficiary group (§s 24 and 26); and
- c). outputting results of the search to the computer device (§31).

Regarding claim 36, **Sherwin** further teaches a search system, comprising:

- a). a database, adapted to store information associating a user with at least one beneficiary group and information associating a provider with at least one

beneficiary group (§9 and Fig. 2); and

b). a controller, adapted to receive a search request from a computer device of a user, adapted to search the database based upon the search request and associated beneficiary group of the user, and adapted to eventually provide a search result to the user including a provider associated with the beneficiary group of the user (§s9, 23 and Fig. 2).

Regarding claims 37, 53, and 62, **Sherwin** further teaches wherein the search request includes a search for one of a good, service and information (§28).

Regarding claims 38, 44, 54, and 60, **Sherwin** further teaches wherein the database is searched in expandable synergistic concentric circles formed based upon the search request and associated beneficiary group of the user (§s 28 and 29).

Regarding claims 45, 111-113 and 120-125, **Sherwin** further teaches computer search method, comprising:

a). storing information for each of a plurality of users of computer devices and for each of a plurality of providers of at least one of goods, services and information, associating each user and each provider with at least one beneficiary group (§s 29 and 30);

b). receiving a search request for at least one of a good, service and information from a computer device of a user (§ 26);

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- c). searching the stored information based upon the search request and the at least one beneficiary group associated with the user (§§ 27 and 31); and
- d). providing a search result to the computer device of the user based upon the search (§ 31).

Regarding claims 46 and 102-103, **Sherwin** further teaches herein the step of providing includes providing the user with at least one provider of the requested good, service or information, associated with the beneficiary group of the user (§27).

Regarding claim 63, **Sherwin** further teaches wherein the controller is adapted to associate a provider with a user by searching the database (§31).

Regarding claim 67, **Sherwin** further teaches wherein the database is further adapted to store a plurality of users, each associated with at least one beneficiary group (§28).

Regarding claim 73, **Sherwin** further teaches wherein a plurality of providers are associated with at least one beneficiary group (§29).

Regarding claims 79, 82, 85, 88, 91, and 116 **Sherwin** further teaches wherein the output results are displayed to the user (§31).

Regarding claims 80, 83, 86, 89, and 92, **Sherwin** further teaches wherein the display includes addresses of providers (§30).

Regarding claims 81, 84, 87, 90, 93, and 106, **Sherwin** further teaches wherein the addresses include at least one of an Internet address and a physical location address (§30).

Regarding claims 98-101 and 114-115, **Sherwin** teaches wherein the beneficiary group is an entity and wherein the beneficiary group includes an entity (§23).

Regarding claims 120-137, **Sherwin** further teaches the association of the user and at least one beneficiary group is pre-designated (§s 29-31).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 7-11, 14-16, 18, 19, 26-29, 30-32, 34, 39, 42, 43, 47, 50, 51, 55, 58, 59, 68, 77 and, 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Sherwin et al.** ("Sherwin") (US 2002/0052784 A1) as applied to claims 1-6, 12, 13, 17, 20-25, 33, 35-38, 40, 41, 44-46, 48, 49, 52-54, 56-57, 60-67, 69-76, 79-137 above in view of **Dunworth et al.** (U.S. Patent 5,930,474).

Regarding claims 7-11, 14-16, 26-29, 30-32, 39, 42, 47, 50, 51, 55, 58, 68, 77 and, 78, **Sherwin** further teaches wherein the step of receiving includes receiving information expansion of the synergistic concentric circles (§28).

Sherwin does not explicitly teach **priority expansion**.

Dunworth, however, teaches **priority expansion** as the database of information is organized into predetermined hierarchy of geographically areas comprising at least a geographical area of relatively small expanse, a geographical area of intermediate expanse, and a geographical area of relatively large expanse (col. 3, lines 46-56; col. 2, lines 42-49).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because

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Dunworth's teaching would have allowed **Sherwin's** to allow the user the flexibility to organize the search information according to user's desire in order to meet user's search criteria (col. 2, lines 54-58).

Regarding claims 18, 34, 43, and 59, **Sherwin** does not explicitly teach wherein a synergistic concentric circle is geographically expandable.

Dunworth, however, teaches wherein a synergistic concentric circle is geographically expandable and priority expansion (col. 13, lines 8-34; col. 3, lines 46-56; col. 2, lines 42-49).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Dunworth's** teaching would have allowed **Sherwin's** to allow the user the flexibility to organize the search information according to user's desire in order to meet user's search criteria (col. 2, lines 54-58).

Regarding claim 19, **Dunworth** further teaches wherein a synergistic concentric circle is expandable based priorities including geographic priorities (col. 13, lines 25-34).

Response to Argument

8. Applicant's arguments with respect to claims 1-137 have been considered but are moot in view of the new ground(s) of rejection.

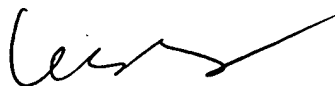
If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge does not apply.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is (703) 305-3018. The examiner can normally be reached on Monday to Friday 9:30am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Leslie Wong
Patent Examiner
Art Unit 2177

LW
12 March 2004